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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/655,520 | 09/05/2000 | Eli M. Noam | | 8435 |

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New York, NY 10027

EXAMINER

GARG, YOGESH C

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| ART UNIT | PAPER NUMBER |
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3625

DATE MAILED: 07/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/655,520

Applicant(s)

NOAM, ELI M.

Examiner

Yogesh C Garg

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 September 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☒ Claim(s) 4-7 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2. 6) ☐ Other: _____

DETAILED ACTION

Objection to Specification

1. Claims do not start on a separate sheet. See Claim or Claims: 37 CFR 1.75 and MPEP § 608.01(m). The claim or claims must commence on separate sheet (37 CFR 1.52(b)). Where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation. There may be plural indentations to further segregate sub combinations or related steps. See 37 CFR 1.75 and MPEP § 608.01(i)-(p).

Claim Objections

2. Claims 4-7 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim should refer to other claims in the alternative only. Dependencies of claims 4-7 has been claimed on all the claims 1, 2 and 3. See MPEP § 608.01(n). Accordingly, the claims 4-7 not been further treated on the merits.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3.1. Claims 1-3 are rejected under 35 U.S.C. 101 because these claims are drafted to include a reference to more than one statutory class of invention, that is, method (process) and system (product). The preambles of claims 1 through 3 claim both a method and system of a payment transaction. Claim 1's elements (a), (b), (c),

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and (d) are directed to the structural elements of the claimed system but further limitations , " such that said access tokens, 1) after being required.....6) and the said access tokens may be redeemed....at the issuers or others are directed to method (process) class of invention. Similarly the limitations of claims 2 and 3 are also directed to structural elements of the claimed system and to method (process) class of the invention. See MPEP 2173.05(p) (ii). Claim Directed to PRODUCT AND PROCESS IN THE SAME CLAIM. A single claim which claims both an apparatus and the method steps of using the apparatus is indefinite under 35 U.S.C. 112, second paragraph. In *Ex parte Lyell*, 17 USPQ2d 1548 (Bd. Pat. App. & Inter. 1990), a claim directed to an automatic transmission work stand and the method steps of using it was held to be ambiguous and properly rejected under 35 U.S.C. 112, second paragraph. Such claims should also be rejected under 35 U.S.C. 101 based on the theory that the claim is directed to neither a "process" nor a "machine," but rather embraces or overlaps two different statutory classes of invention set forth in 35 U.S.C. 101 which is drafted so as to set forth the statutory classes of invention in the alternative only. *Id.* at 1551.

3.2. Claims 1-3 are rejected under 35 U.S.C. 101 because the claimed inventions are directed to non-statutory subject matter. Claims 1-3 are directed to disembodied data structure claim which are per se not statutory. See *C.f. In re Wamerdam*. The examiner suggests redrafting the claims to include a computer readable medium so that the claimed software in combination with a computer readable medium will be capable of producing a useful, concrete and tangible result. A claim to a computer readable medium encoded with functional descriptive material that can

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function with a computer to effect a practical application that results in a useful, concrete and tangible result (i.e. running an assembly line or executing a stock transaction or executing a transaction) satisfies Section 101. See U.S. Patent 5,710,578 to Beauregard etc. These are merely stored to be read or outputted by a computer without any functional interrelationship, and thus do not impart functionality to the computer, i.e., they are not computer components. **Examples of Non-Functional Descriptive Material: Music, Literature, Art, Photographs, Data base.**

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

- 4.1. Claims 1-3 are rejected as failing to define the invention in the manner required by 35 U.S.C. 112, second paragraph.

The claim(s) are narrative in form and replete with indefinite and functional or operational language. The structure which goes to make up the device must be clearly and positively specified. The structure must be organized and correlated in such a manner as to present a complete operative device. The claim(s) must be in one sentence form only. Note the format of the claims in the patent(s) cited.

- 4.2. Claims 1-3 are also rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention because they claim both system (an apparatus) and method (process) in the same claim. See MPEP 2173.05(p). Claim

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Directed to Product and Process II. PRODUCT AND PROCESS IN THE SAME CLAIM.

A single claim which claims both an apparatus and the method steps of using the apparatus is indefinite under 35 U.S.C. 112, second paragraph. In *Ex parte Lyell*, 17 USPQ2d 1548 (Bd. Pat. App. & Inter. 1990), a claim directed to an automatic transmission work stand and the method steps of using it was held to be ambiguous and properly rejected under 35 U.S.C. 112, second paragraph. Such claims should also be rejected under 35 U.S.C. 101 based on the theory that the claim is directed to neither a "process" nor a "machine," but rather embraces or overlaps two different statutory classes of invention set forth in 35 U.S.C. 101 which is drafted so as to set forth the statutory classes of invention in the alternative only. *Id.* at 1551.

4.3. Claims 1 and-3 are also rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention because in claim 1 there is no relationship indicated between the structural element c)-a software program, located at the facilities- and other structural elements a, b, and d as how they are integral and related to each other to execute an application, in claim 2, there is no relationship indicated between the structural element a) electronic money and b) -a software control program as how they are integral and related to each other to execute an application, and in claim 3, there is no relationship indicated between the structural element b)-a software program, located at the facilities- and other structural elements a, and c as how they are integral and related to each other to execute an application.

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5. **Treatment of claims 1-3 on merits in view of above USC 101 and USC 112, second paragraph rejections.** As best understood by the examiner, claims 1-3 will be treated as system claims; comprising of structural elements: access tokens known as electronic money denominated at a certain value stored in a computer readable memory being used for payment against transactions between two remote computerized bodies using a software control program. All method steps attributed to access tokens in claims 1 and 3 and the method steps attributed to the intelligent agent in claim 2 are not accorded patentable weight.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6.1. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Wong et al. (US Patent 5,913,203), hereinafter referred to Wong.

With regards to system claims 1-3, Wong discloses access tokens known as electronic money denominated at a certain value stored in a computer readable memory being used for payment against transactions between two remote computerized bodies using a software control program (see at least abstract, FIGS. 1-3, col.3, line 40—col.5, line 44, col.7, line 41-col.8, line 67).

6.2. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by

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Mori et al. (US Patent 5,854,581), hereinafter referred to Mori.

With regards to system claims 1-3, Mori discloses access tokens known as electronic money denominated at a certain value stored in a computer readable memory being used for payment against transactions between two remote computerized bodies using a software control program (see at least abstract, FIGS. 1-2, 7-11, col.2, line 15—col.6, line 16 col.7, line 39-col.17, line 16).

6.3. e) Recent Statutory Changes to 35 U.S.C. § 102(e)

On November 2, 2002, President Bush signed the 21st Century Department of Justice Appropriations Authorization Act (H.R. 2215) (Pub. L. 107-273, 116 Stat. 1758 (2002)), which further amended 35 U.S.C. § 102(e), as revised by the American Inventors Protection Act of 1999 (AIPA) (Pub. L. 106-113, 113 Stat. 1501 (1999)). The revised provisions in 35 U.S.C. § 102(e) are completely retroactive and effective immediately for all applications being examined or patents being reexamined. Until all of the Office's automated systems are updated to reflect the revised statute, citation to the revised statute in Office actions is provided by this attachment. This attachment also substitutes for any citation of the text of 35 U.S.C. § 102(e), if made, in the attached Office action.

The following is a quotation of the appropriate paragraph of 35 U.S.C. § 102 in view of the AIPA and H.R. 2215 that forms the basis for the rejections under this section made in the attached Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

35 U.S.C. § 102(e), as revised by the AIPA and H.R. 2215, applies to all qualifying references, except when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. For such patents, the prior art date is determined under 35 U.S.C. § 102(e) as it existed prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. § 102(e)).

The following is a quotation of the appropriate paragraph of 35 U.S.C. § 102 prior to the amendment by the AIPA that forms the basis for the rejections under this section made in the attached Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

For more information on revised 35 U.S.C. § 102(e) visit the USPTO website at www.uspto.gov or call the Office of Patent Legal Administration at (703) 305-1622.

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6.4. Claims 1-3 are rejected under 35 U.S.C. 102(e) as being anticipated by Ohki et al. (US Patent 5,952,639), hereinafter referred to Ohki.

With regards to system claims 1-3, Ohki discloses access tokens known as electronic money denominated at a certain value stored in a computer readable memory being used for payment against transactions between two remote computerized bodies using a software control program (see at least abstract, col.2, line 14—col.4, line 39, col.5, lines 5-54, col.6, line 62-col.7, line 58).

6.5. Claims 1-3 are rejected under 35 U.S.C. 102(e) as being anticipated by Teicher (US Patent 6,467,685).

With regards to system claims 1-3, Teicher discloses access tokens known as electronic money denominated at a certain value stored in a computer readable memory being used for payment against transactions between two remote computerized bodies using a software control program (see at least abstract, col.2, line 3-col.13, line 20).

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

7.1. US Patents 6,029,151 to Nikander, 6,119,946 to Teicher, 6,338,048 B1 to Mori and US Publications H1794 to Claus, and US 2001/0051920 A1 to Jao et al. disclose electronic money denominated at a certain value stored in a computer readable

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memory being used for payment against transactions between two remote computerized bodies using a software control program.

7.2. Sheehan, Kevin P., " Electronic Cash "; FDIC Banking Review, Washington 1998, Vol.11, ISS.2, pgs 1-8, extracted from Internet web site <http://proquest.umi.com> on 06/25/2003 and Talmor, Sharon; " A chip off the old stripe "; The Banker, London; Oct 1994, pgs 1-4; extracted from Internet web site <http://proquest.umi.com> on 06/25/2003 disclose electronic money denominated at a certain value stored in a computer readable memory being used for payment against transactions between two remote computerized bodies using a software control program.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C Garg whose telephone number is 703-306-0252. The examiner can normally be reached on M-F (8:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn W Coggins can be reached on 703-308-1344. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

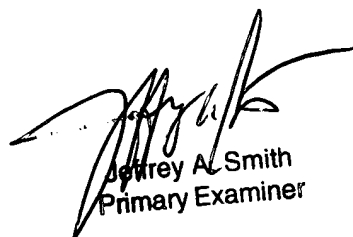
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Yogesh C Garg
Examiner
Art Unit 3625

YCG
June 27, 2003



Jeffrey A. Smith
Primary Examiner

It appears that the applicant in this application is a *pro se* applicant (an inventor filing the application alone without the benefit of a Patent Attorney or Agent). Applicant may not be aware of the preferred methods of ensuring timely filing of responses to communications from the Office and may wish to consider using the Certificate of Mailing or the Certificate of Transmission procedures outlined below.

CERTIFICATE OF MAILING

To ensure that the Applicant's mailed response is considered timely filed, it is advisable to include a "certificate of mailing" on at least one page (preferably on the first page) of the response. This "certificate" should consist of the following statement:

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: "Commissioner of Patents and Trademarks, Washington, D.C. 20231" on (date).

(Typed or printed name of the person signing this certificate)

(signature)

CERTIFICATE OF TRANSMISSION

Alternatively, if applicant wishes to respond by facsimile rather than by mail, another method to ensure that the Applicant's response is considered timely filed, is to include a "certificate of transmission" on at least one page (preferably on the first page) of the response. This method should be used by foreign applicants without access to the U.S. Postal Service. This "certificate" should consist of the following statement:

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office, Fax No. (703)____-____ on (date).

(Typed or printed name of the person signing this certificate)

(signature)

These "Certificates" may appear anywhere on the page, and may be handwritten or typed. They must be signed, and the date must be the actual date on which it is mailed or transmitted. For the purpose of calculating extensions of time, the date shown on the certificate will be construed as the date on which the paper was received by the Office, regardless of the date the U.S. Postal Service actually delivers the response, or the fax is "date-stamped" in. In this way, postal or transmission delays do not affect the extension-of-time fee.

In the event that a communication is not received by the Office, applicant's submission of a copy of the previously mailed or transmitted correspondence showing the **originally** signed Certificate of Mailing or Transmission statement thereon, along with a statement from the person signing the statement which attests to the timely mailing or transmitting of the correspondence, would be sufficient evidence to entitle the applicant to the mailing or transmission date of the correspondence as listed on the Certificate of Mailing or Transmission, respectively.

NOTICE TO APPLICANT: In the case of lost or late responses the use of other "receipt producing" forms of mailing a correspondence to the Patent Office, such as Certified Mail, or a private shipper such as FedEx, **WILL NOT** result in the applicant getting the benefit of the mailing date on such receipts. These receipts are not considered to be acceptable evidence since there is nothing to "tie-in" the receipt with the particular document allegedly submitted.